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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/063,988	05/31/2002	David Carroll Challener	RPS920020047	3826
25299	7590	12/12/2005		
IBM CORPORATION PO BOX 12195 DEPT YXSA, BLDG 002 RESEARCH TRIANGLE PARK, NC 27709			EXAMINER ABYANEH, ALI S	
			ART UNIT	PAPER NUMBER
			2137	

DATE MAILED: 12/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/063,988

Applicant(s)

CHALLENGER ET AL.

Examiner

Ali S. Abyaneh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/12/02, 8/8/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-14 are presented for examination.

Information Disclosure Statement PTO-1449

2. The Information Disclosure Statement submitted by applicant on 08-08-2005 and 07-12-2002 has been considered. Please see attached PTO-1449.

Claim Objections

3. Claim 1-14 are objected to because of the following informalities:

Using brackets "[]" around the claim numbers and "c" before the claim numbers are inappropriate. Brackets and "c" should be removed from the claim numbers, for example, in claim 1, "[c1]" should be changed to "1".

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1,2, 4, 7, 8, 9-11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (US Publication NO 2003/0046542) in view of Gary et al. (US Patent NO 6,087,955).

Regarding claim 1

Chen teaches an apparatus comprising: a computer system motherboard; a security element coupled to said motherboard and enabling operation as a trusted computer platform; a first input device coupled to said motherboard and enabling input of data to said security element (paragraph [0034]). Chen does not explicitly teach a second input device selectively interposed between said first input device and said security element and enabling selective imposition of a security requirement for effective input of data to said security element from said first input device. However, in an analogous art, Gray teaches a second input device selectively interposed between said first input device and said security element and enabling selective imposition of a security requirement for effective input of data to said security element from said first input device (column 4, lines 44-52). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus disclosed by Chen to include a second input device selectively interposed between said first input device and said security element and enabling selective imposition of a security requirement for effective input of data to said security element from said first input device. This would have been obvious because person having ordinary skill in the art at the time the invention was made would have been motivated to do so in order to enforce access control to one or more application programs running on the computer and furthermore to verify data entered through a

keyboard with the data stored on a token such as a card, while isolating the entered data from the computer (column 2, lines 50-52).

Regarding claim 9

Chen teaches an apparatus comprising: a computer system motherboard; a security element mounted on said motherboard and enabling operation as a trusted computer platform; a first input device coupled to said motherboard and enabling input of data to said security element (paragraph [0034]). Chen does not explicitly teach a second input device coupled to said first input device and said security element and enabling imposition of a security requirement for effective input of data to said security element from said first input device; and a switch interposed between said second input device and said first input device and said security element and enabling selective interposition of said second input device between said first input device and said security element. However, in an analogous art Gray teaches a second input device coupled to said first input device and said security element and enabling imposition of a security requirement for effective input of data to said security element from said first input device (column 4, lines 44-52); and a switch interposed between said second input device and said first input device and said security element and enabling selective interposition of said second input device between said first input device and said security element (column 6, lines 1-12). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention

was made to modify the apparatus disclosed by Chen to include a second input device coupled to said first input device and said security element and enabling imposition of a security requirement for effective input of data to said security element from said first input device; and a switch interposed between said second input device and said first input device and said security element and enabling selective interposition of said second input device between said first input device and said security element. This would have been obvious because person having ordinary skill in the art at the time the invention was made would have been motivated to do so in order to enforce access control to one or more application programs running on the computer and furthermore to verify data entered through a keyboard with the data stored on a token such as a card, while isolating the entered data from the computer (column 2, lines 50-52).

Regarding claim 10

Chen teaches a method comprising the steps of: coupling a keyboard to a security element in a trusted computing platform system to enable entry of data to the security element (paragraph [0034]). Chen does not explicitly teach selectively interposing between the keyboard and the security element a second input device imposing a security requirement for effective entry of data to the security element from the keyboard. However, in an analogous art, Gray teaches selectively interposing between the keyboard and the security element a second input device imposing a security requirement for effective entry of data to the

security element from the keyboard (column 4, lines 44-52). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus disclosed by Chen to include selectively interposing between the keyboard and the security element a second input device imposing a security requirement for effective entry of data to the security element from the keyboard. This would have been obvious because person having ordinary skill in the art at the time the invention was made would have been motivated to do so in order to enforce access control to one or more application programs running on the computer and furthermore to verify data entered through a keyboard with the data stored on a token such as a card, while isolating the entered data from the computer (column 2, lines 50-52).

Regarding claims 2 and 4

Chen and Gray teach all limitation of the claim as applied to claim 1 above. Chen furthermore teaches an apparatus, wherein said security element is mounted on said motherboard, and said first input device is a keyboard

Regarding claims 7 and 8

Chen and Gray teach all limitation of the claim as applied to claim 1 above. Gary furthermore teaches an apparatus, wherein said second input device is a card reader (column 4, line 67-column 5, line1) and a switch interposed between said second input device and said security element and

selectively enabling interposition of second input device (column 6, lines 1-12).

Regarding claim 11

Chen and Gray teach all limitation of the claim as applied to claim 10 above. Gary furthermore teaches a method, wherein the step of selectively interposing a second input device comprises switching the state of connection of a second input device between being interposed and being excluded from interposition (column 6, lines 1-12).

Regarding claim 12

Chen and Gray teach all limitation of the claim as applied to claim 10 above. Gary furthermore teaches wherein the step of selectively interposing a second input device and imposing a security requirement comprises imposing a requirement for entry of a numeric sequence (column 6, lines 13-24).

Regarding claim 14

Chen and Gray teach all limitation of the claim as applied to claim 10 above. Gary furthermore teaches a method, wherein the step of selectively interposing a second input device and imposing a security requirement comprises imposing a requirement for submission of a physical key (column 5, lines 28-52).

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (US Publication NO 2003/0046542) in view of Gray et al. (US Patent NO 6,087,955) further in view of Harari et al. (US Patent NO 6,266,724).

Regarding claim 3

Chen and Gray teach all limitation of the claim as applied to claim 2 above. Chen furthermore teaches a motherboard with a security element socket ((paragraph [0034]) ("other standard component")). Chen and Gray do not explicitly teach an apparatus comprising a daughter card and security element mounted on said daughter card. However, in an analogous art, Harari teaches an apparatus comprising daughter card (column 8, lines 24-36). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus disclosed by Chen and Gray to include a daughter card and security element mounted on said daughter card. This would have been obvious because person having ordinary skill in the art at the time the invention was made would have been motivated to do so in order to allow the functional components of a peripheral implemented on a PC card to be advantageously partitioned and furthermore to allow the user to add or decrease memory capacity (column 44, lines 16-18).

7. Claims 5, 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (US Publication NO 2003/0046542) in view of Gray et al. (US Patent

NO 6,087,955) further in view of Gokcebay (US Patent NO 5,337,043).

Regarding claims 5, 6 and 13

Chen and Gray teach all limitation of the claim as applied to claims 1 and 10 above. Chen and Gray do not explicitly teach an apparatus/method, wherein said second input device is a keypad or biometric measuring device and the step of selectively interposing a second input device and imposing a security requirement comprises imposing a requirement for entry of a biometric measurement. However, in an analogous art, Gokcebay teaches an apparatus/method, wherein said second input device is a keypad or biometric measuring device and the step of selectively interposing a second input device and imposing a security requirement comprises imposing a requirement for entry of a biometric measurement (column, lines 20-27). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus/method disclosed by Chen and Gray to include an apparatus/method, wherein said second input device is a keypad or biometric measuring device and the step of selectively interposing a second input device and imposing a security requirement comprises imposing a requirement for entry of a biometric measurement. This would have been obvious because person having ordinary skill in the art at the time the invention was made would have been motivated to do so in order to provide an access control system which has a key reader for reading the encoded data on the key, and a reader of the

attempted user's biometric feature such as a finger print (column 7, lines 15-19).

References Cited, Not Used

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

1. U.S. Patent No. 6,138,239

This reference relates to a method for executing secure transactions of a computer system.

2. U.S. Patent No. 6,426,742

This reference relates to a method for controlling switch of input mode of keyboard instruction.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Abyaneh whose telephone number is (571) 272-7961. The examiner can normally be reached on Monday-Friday from (8:00-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone numbers for the organization where this application or proceeding is assigned as (571) 273-8300 Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

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more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ali Abyaneh *A.A*
Patent Examiner
Art Unit 2137
12/07/05

E. L. Moise
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